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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,190	11/23/1999	HIROMI YOSHINARI	450106-4749	3610
20999	7590	01/24/2005		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER BURD, KEVIN MICHAEL	
			ART UNIT	PAPER NUMBER
			2631	
DATE MAILED: 01/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/381,190

Applicant(s)

YOSHINARI ET AL.

Examiner

Kevin M. Burd

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

1. This office action, in response to the amendment filed 10/12/2004, is a final office action.

***Response to Arguments***

2. Applicant's arguments filed 10/12/2004 have been fully considered but they are not persuasive. Applicant has added the new limitation of "wherein the editing device matches a phase of the second base band signal with stored codec information corresponding to cue information" in each of the independent claims. A rejection under 25 USC 112 first paragraph is stated below. In addition, Yamamoto discloses the combiner 50 and MPEG encoder 51 in figure 6. The combiner discloses combining the signals from the MPEG video decoders 48A and 48b. Yamamoto also discloses combining information from blocks 52-54 which comprises ending notice information, non-participating image data information and absence notification image information (column 7, line 66 to column 8, line 13). The combiner will overlay these additional images. Therefore, the combiner will match the timing (phase) of the video signal with these images. The timing is matched in that the signals will be displayed at the same time. For these reasons and the reasons stated below, claims 1-27 are rejected.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear where in the specification, the limitation of "the editing device matches a phase of the second base band signal with stored codec information corresponding to cue information" is found.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto (US 5,991,276).

Regarding claims 1, 8, 15, 16 and 19, Yamamoto discloses the method of combining information from a number of user terminals each comprising a user that can join the video conference (column 7, lines 22-25). The method includes inputting a plurality of different signals into a plurality of MPEG Video decoders (figure 7, elements

48a and 48b). The video data, containing "codec information", is combined in video data combiner 50 and encoded in MPEG video encoder 51. This re-encoded data is output. Managers 52, 53 and 54 control the combining of the data as shown in figure 7. Yamamoto also discloses combining information from managers 52, 53 and 54 which comprise ending notice information, non-participating image data information and absence notification image information (column 7, line 66 to column 8, line 13). The combiner will overlay these additional images. Therefore, the combiner will match the timing (phase) of the video signal with these images. The timing is matched in that the signals will be displayed at the same time as the video signals. Additional information about the decoding, combining and re-encoding of data is found in column 6, line 18 to column 8, line 24.

Regarding claims 2, 9, 17 and 20, the combination of the data streams is done as stated in column 7, line 53 to column 8, line 19.

Regarding claims 3 and 10, the first and second base band signals are re-encoded in the combiner 50.

Regarding claims 4 and 11, the encoded data is output of the AAL5 interfaces and the re-encoded data is output to the AAL5 interfaces as shown in figure 6.

Regarding claims 5-7 and 12-14, the inputted bit streams are MPEG video. The video can contain any type of information.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 18 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (US 5,991,276).

Regarding claims 18 and 21, Yamamoto discloses a method of combining compressed video streams as stated above. Yamamoto does not disclose storing the output of the decoders or storing the "codec information". However, it would have been obvious for one of ordinary skill in the art at the time of the invention to store this information. If errors were to occur at the output of the system, error checks at each stage of the re-encoding process would be possible. Eliminating the need to check each step of the re-encoding process if the output from each component was known would reduce the error correction process time.

Regarding claims 22-27, Yamamoto discloses the method of combining information from a number of user terminals each comprising a user that can join the video conference (column 7, lines 22-25). The method includes inputting a plurality of different signals into a plurality of MPEG Video decoders (figure 7, elements 48a and 48b). The video data, containing "codec information", is combined in video data combiner 50 and encoded in MPEG video encoder 51. This re-encoded data is output. Managers 52, 53 and 54 control the combining of the data as shown in figure 7.

Yamamoto also discloses combining information from managers 52, 53 and 54 which comprise ending notice information, non-participating image data information and absence notification image information (column 7, line 66 to column 8, line 13). The combiner will overlay these additional images. Therefore, the combiner will match the timing (phase) of the video signal with these images. The timing is matched in that the signals will be displayed at the same time as the video signals. Additional information about the decoding, combining and re-encoding of data is found in column 6, line 18 to column 8, line 24. Yamamoto does not disclose storing the output of the decoder nor storing the "codec information" however, it would have been obvious for one of ordinary skill in the art at the time of the invention to store this information. If errors were to occur at the output of the system, error checks at each stage of the re-encoding process would be possible. Eliminating the need to check every step of the re-encoding process if the output from each component was known would reduce the error correction process time.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Burd whose telephone number is (571) 272-3008. The examiner can normally be reached on Monday - Thursday 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on (571) 272-3021. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin M. Burd  
1/20/2005

**KEVIN BURD**  
**PRIMARY EXAMINER**